

REMARKS

In response to the Office Action dated July 12, 2005, Applicants file herewith a Petition to Revive an Unintentionally Abandoned Application Under 37 C.F.R. 1.137(b) and a Response to the Office Action. Applicants respectfully request reconsideration. The application is believed to be in allowable condition.

Claims 1, 21, 32, 41, 51, 71 and 87 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Examiner indicated that the inventions are not in the technological arts because they are not of a computer method or system. Claims 1, 21, 41, 51, 71 and 87 have been canceled without prejudice, rendering rejection as to these claims moot.

Applicant respectfully submits that claim 32 is directed to statutory subject matter under 35 U.S.C. § 101, and provides a practical application in the technological arts. Applicant respectfully requests reconsideration and withdrawal of this rejection in light of the discussion below.

The invention claimed in independent claim 32 provides a practical application in the technological arts, including an integrated computer system and a method performed at least partially by a programmed computer to implement and administer an investment guidance system. The investment guidance system includes the input of one or more input decisions related to the probability of achieving a financial goal, and weighting the importance of the one or more input decisions to determine a rating for an asset based on the input decisions.

Providing a practical application in the technological arts, however, is not a requirement under U.S. patent law. 35 U.S.C. § 101 states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Federal Circuit states, in its decision in *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368, 1372 (Fed Cir. 1998):

The plain and unambiguous meaning of § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in title 35, i.e., those found in §§ 102, 103 and 112, second paragraph. The repetitive use of the expansive term “any” in § 101 shows Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980); *see also, Diamond v. Diehr*, 450 U.S. 175, 182 (1981). Thus, it is improper

to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. *See, Chakrabarty*, 447 U.S. at 308 (“We have also cautioned that courts should not read into the patent laws limitations and conditions which the legislature has not express . . .”

[A]fter *Diehr* and *Alappat*, the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter. *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557.

The *State Street Bank* decision involved subject matter directed to problems of administering a group of mutual funds. The patent at issue in the *State Street* decision includes method claim 1 that produces a useful, concrete and tangible result. Even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss, a useful result renders the method statutory subject matter. Applicant respectfully submits the claimed invention of claim 32 produces useful, concrete and tangible results. Specifically, each of claims 1, 21, 32, 41, 51, 71 and 87 produces a novel and flexible investment guidance system.

It is noted that inclusion of a computer system, a server and various server components into a claim that otherwise produces a useful, concrete and tangible result is not a requirement for the claim to recite statutory subject matter.

In addition to the *State Street Bank* decision, MPEP 706.03(a) gives examples of subject matter that are not patentable under 35 U.S.C. § 101, including printed matter, a naturally occurring article, and a scientific principle. The investment guidance system of claims 1, 21, 32, 41, 51, 71 and 87 is not covered by these examples and therefore constitutes patentable subject matter. Further, there is not a “technological arts” test to determine patentable subject matter under § 101. *Ex parte Lundgren* (USPTO Bd. Pat. Apps., April 20, 2004). Thus, claim 32 is patentable under 35 U.S.C. 101.

Claims 1-11, 13-18, 21-61, 63-69, 71-91, 94-102 and 106-112 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,275,814 (Giansante). Claims 1-11, 13-18, 21-31, 41-47, 49-77, 87-89, 91, 94-102 and 106-112 have been canceled without prejudice, rendering rejection as to these claims moot. As discussed below, claims 32-40, 48, 78-86 and 90 are patentable over Giansante.

Independent claim 32 is directed to a method for providing financial assistance in an investment guidance system. The method includes receiving a financial goal from a user, receiving one or more input decisions upon which the probability of achieving said financial goal is dependent, wherein one of the input decisions includes selecting an asset allocation based on

investment risk, determining the probability of achieving said financial goal, receiving an indication that said user has selected a target asset allocation investment plan in order to achieve said financial goal, receiving a request to rate a plurality of assets within a selected asset class, providing two or more criteria associated with said assets for said user to evaluate, receiving a relative weight of importance for said two or more criteria based on the user's personal investment preferences, determining a rating for each asset based on the relative weights assigned to said two or more criteria, ranking plurality of said assets based on said rating, receiving a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan, and executing said trade for one or more of the selected ranked assets.

Giansante discusses an investment portfolio selection system. Assets that have a statistical variation that falls within an expected investment return are presented for selection by a user, as opposed to a precise efficiency frontier. Both subjective and objective criteria are used to reduce a candidate set of funds to between 50 and 100 funds. From this list, a return and a risk is assigned to each asset, and portfolios are optimized across industry sectors and investments styles for different mutual funds and risk levels. From this, the user enters particular criteria and is placed in a risk bracket, which results in particular assets that the user can buy.

Giansante does not teach or suggest receiving a relative weight of importance for two or more criteria based on a user's personal investment preferences, determining a rating for each asset based on the relative weights assigned to said two or more criteria, ranking plurality of said assets based on said rating, receiving a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan, and executing said trade for one or more of the selected ranked assets, as recited in claim 32. For at least these reasons, claim 32 is patentable over Giansante. Claims 33-40 depend, directly or indirectly, from claim 32 and are patentable for at least the reasons that claim 32 is patentable.

Independent claim 48 is directed to an investment guidance system for providing financial planning assistance for Internet users. The system includes a memory for storing asset information, a processor connected to said memory, a transmitter connected to said processor to enable processor to transmit information to a user system by means of the Internet; and a receiver connected to said processor to allow said processor to receive information from a user system by means of the Internet. The processor receives a financial goal from a user and the processor receives one or more input decisions upon which the probability of achieving said financial goal is dependent, wherein one of the input decisions includes selecting an asset allocation based on

investment risk. The processor determines the probability of achieving said financial goal. The processor receives an indication that said user has selected a target asset allocation investment plan in order to achieve said financial goal. The processor receives a request to rate a plurality of assets within a selected asset class, provides two or more criteria associated with said assets for said user to evaluate, receives a relative weight of importance for said two or more criteria based on the user's personal investment preferences, determines a rating for each asset based on the relative weights assigned to said two or more criteria, ranks plurality of said assets based on said rating, receives a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan, and executes said trade for one or more of the selected ranked assets.

Giansante fails to teach or disclose a processor that receives a request to rate a plurality of assets within a selected asset class, provides two or more criteria associated with said assets for said user to evaluate, receives a relative weight of importance for said two or more criteria based on the user's personal investment preferences and determines a rating for each asset based on the relative weights assigned to the criteria, as recited in claim 48. Nor does the system in Giansante rank a plurality of said assets based on said rating, receive a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan, and execute said trade for one or more of the selected ranked assets, all of which is also recited in claim 48. For at least these reasons, claim 48 is patentable over Giansante.

Independent claim 78 is directed to an investment guidance system for providing financial planning assistance, comprising means for receiving a financial goal from a user, means for receiving one or more input decisions upon which the probability of achieving said financial goal is dependent, wherein one of the input decisions includes selecting an asset allocation based on investment risk, means for determining the probability of achieving said financial goal, means for receiving an indication that said user has selected a target asset allocation investment plan in order to achieve said financial goal, means for receiving a request to rate a plurality of assets within a selected asset class, means for providing two or more criteria associated with said assets for said user to evaluate, means for receiving a relative weight of importance for said two or more criteria based on the user's personal investment preferences, means for determining a rating for each asset based on the relative weights assigned to said two or more criteria, means for ranking plurality of said assets based on said rating, means for receiving a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan, and means for executing said trade for one or more of the selected ranked assets.

As discussed above with respect to claim 32, Giansante fails to teach or disclose means for determining a rating for an asset based on the relative weights assigned to said two or more criteria, means for ranking plurality of said assets based on said rating, means for receiving a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan, and means for executing said trade for one or more of the selected ranked assets, as recited in claim 78. For at least these reasons, claim 78 is patentable over Giansante. Claims 79-86 depend directly from claim 78 and are patentable for at least the reasons that claim 78 is patentable.

Independent claim 90 is directed to an investment guidance system for providing financial planning assistance, comprising a storage device storing a program, a processor in communication with the storage device, the processor operative with the program to: receive a financial goal from a user, receive one or more input decisions upon which the probability of achieving said financial goal is dependent, wherein one of the input decisions includes selecting an asset allocation based on investment risk; determine the probability of achieving said financial goal; receive an indication that said user has selected a target asset allocation investment plan in order to achieve said financial goal; receive a request to rate a plurality of assets within a selected asset class, provide two or more criteria associated with said assets for said user to evaluate, receive a relative weight of importance for said two or more criteria based on the user's personal investment preferences, determine a rating for each asset based on the relative weights assigned to said two or more criteria, rank plurality of said assets based on said rating, receive a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan; and execute said trade for one or more of the selected ranked assets.

As discussed above with respect to claim 32, Giansante fails to teach or suggest a system in which the processor receives a relative weight of importance for two or more criteria based on the user's personal investment preferences, determines a rating for each asset based on the relative weights assigned to said two or more criteria, ranks plurality of said assets based on said rating, receives a request to execute a trade for one or more of the ranked assets in order to fulfill said target asset allocation investment plan, and execute said trade for one or more of the selected ranked assets, as recited in claim 90. For at least these reasons, claim 90 is patentable over Giansante.

Applicant: Robert K. Samson
U.S.S.N.: 09/766,277

Claims 12, 19, 20, 62, 70, 92, 93 and 103-105 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Giansante. Claims 12, 19, 20, 62, 70, 92, 93 and 103-105 have been canceled without prejudice, rendering rejection as to these claims moot.

Applicant respectfully requests that a notice of allowance be issued. To answer any questions, or otherwise further the prosecution of this application, the Examiner may contact the undersigned attorney at the number provided below.

Respectfully submitted,


Alison L. McCarthy, Esq. (Reg. No. 51,998)
Attorney for Applicant
Mintz, Levin, Cohn, Ferris
Glovsky and Popeo, P.C.
Telephone: (617) 542-6000
Facsimile: (617) 542-2241
Customer No. 30623

Date: May 10, 2006

TRA 2150885v.1